

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In order to advance prosecution, the applicants have canceled claim 11 without prejudice and have amended claims 1 and 15-18, and added claims 19-21. Claims 19-21 encompass subject matter previously contained in claim 18. The amendments to the claims, including the cancellation of claim 11, are made solely to clarify the invention and to expedite the issuance of the claims. Any admission regarding the patentability of this subject matter is not intended and should not be construed. Moreover, the amendments do not add new matter. The basis for the amended claims can be found in the original claims and throughout the specification. Claims 1-10 and 15-21 are now pending in this application.

Turning to the Office action, claim 18 stands rejected under 35 U.S.C. § 112, second paragraph for failing to particularly point out and distinctly claim the subject matter regarded by the applicant as the invention. Specifically, the Action asserts that claim 18 is confusing because SEQ ID NO: 8 is only 92 amino acids. Applicants have amended claim 18 and added claims 19-21 to clarify the invention. Applicants respectfully contend that the amendments render the rejections under 35 U.S.C. §112 moot. Accordingly, the Applicants respectfully request withdrawal of this 35 U.S.C. §112, second paragraph, rejection against claim 18.

Claims 1-10 and 15-18 stand rejected under 35 U.S.C. § 112, first paragraph for failing to provide an adequate written description and for lack of enablement. Specifically, the Action points out that the specification provides written description and enablement for the serine protease inhibitors of SEQ ID NOs: 49, 2, 45, 47, 71, 70, 4, 5, 6, 7, 3, 50, 1, 52, and 8, but the Action asserts that lack written description and enablement for any serine protease inhibitor that comprises those sequences. Applicants have amended claim 1 to encompass the inhibitors of SEQ ID NOs: 49, 2, 45, 47, 71, 70, 4, 5, 6, 7, 3, 50, 1, 52, and 8. Applicants respectfully contend that the amendments render the rejections under 35 U.S.C. §112, first paragraph, moot. Consequently, the Applicants respectfully submit that withdrawal of this 35 U.S.C. §112, first paragraph, rejection of claims 1-10 and 15-18 is in order and is respectfully requested.

Claims 1-10 and 15-18 stand rejected under 35 U.S.C. § 103 as unpatentable over Tamburini et al. in view of Rasche et al. and O'Riordan et al. These references do not teach, either alone or in combination, use of the specific serine protease inhibitors of the invention as shown in amended claim 1 for increasing the rate of mucociliary clearance in a subject.

Consequently, Applicants respectfully contend the claims as amended are not rendered obvious by the cited references. Accordingly, Applicants respectfully submit that withdrawal of this 35 U.S.C. § 103 rejection against claims 1-10 and 15-18 is in order and is respectfully requested.

Claims 1-10 and 15-18 stand provisionally rejected under the doctrine of obviousness-type double patenting over claims 1-10 and 15-18 of co-pending Application 09/218,913. A terminal disclaimer is filed herewith, thereby obviating this ground of rejection. Accordingly, Applicants respectfully request withdrawal of this obviousness-type double patenting rejection against claims 1-10 and 15-18.

In view of the amendments and remarks above, the application is considered to be in good and proper form for allowance. Therefore, the Patent Office is respectfully requested to pass the application to issue. If, in the opinion of the Patent Office, a telephone conference would expedite the prosecution of this application, the Office is invited to call the undersigned attorney.

Respectfully submitted,

Dated: 1/5/04



Emily Miao
Reg. No. 35,285

McDONNELL BOEHNEN
HULBERT & BERGHOFF
300 South Wacker Drive
32nd Floor
Chicago, Illinois 60606
312-913-0001 (telephone)
312-913-0002 (facsimile)